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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,010	11/30/2001	Chiharu Nishizawa	Q67460	4232

7590 08/13/2003
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2100 Pennsylvania Avenue NW
Washington, DC 20037

EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,010

Applicant(s)

NISHIZAWA ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The request filed on June 9, 2003 for Continued Prosecution under 37 CFR 1.114 based on parent Application No. 09/980010 is acceptable and an RCE has been established. An action on the RCE follows.

Specification

2. The disclosure is objected to because of the following informalities, appropriate correction is required:

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph.

4. The amendment filed June 9, 2003 corrects many of the errors in the specification, but does not correct all of the grammatical and typographical errors present in the rest of the specification.

5. The applicant's amendment filed June 9, 2003 overcomes the objection to claim 6 that was presented under this heading in paragraph 5 of the previous office action.

Claim Rejections - 35 USC § 112

6. The amendment filed June 9, 2003 overcomes all of the rejections put forth under this heading in the previous office action.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. The examiner maintains all rejections put forth under this heading in the previous office action. The rejections are repeated below.
9. Claims 1, 9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ormsby et al. as evidenced by Bright.

Paragraph 7 of the previous office action contains the text for this rejection. Newly added claim 13 is a product-by-process claim. In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant has not shown that the method by which the product is made causes the product to be patentably distinct from the product produced by the reference(s). Specifically, the applicant has not shown that bending a laminate structure to form a lens imparts to the lens any properties that would make it patentably distinct from the molded lens in Ormsby. This rejection under 35 U.S.C. 102 is

therefore proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. The examiner maintains all rejections put forth under this heading in the previous office action. The rejections are repeated below.

12. Claims 1, 3-4, 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okoroafor et al. in view of Ormsby et al. as evidenced by Bright.

Paragraph 9 of the previous office action contains the text of this rejection. Newly added claim 13 is a product-by-process claim. In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant has not shown that the method by which the product is made causes the product to be patentably distinct from the product produced by the reference(s). Specifically, the applicant has not shown that bending a laminate structure to form a lens imparts to the lens any properties that would make it patentably distinct from the molded lens made by the combination of Okoroafor et al. and Ormsby et al. This rejection under 35 U.S.C. 103 is therefore proper because the "patentability

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of a product does not depend on its method of production.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

13. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ormsby et al. as evidenced by Bright as applied to claim 1 above, and further in view of Perrott et al.

Paragraph 10 of the previous office action contains the text of this rejection.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ormsby et al. as evidenced by Bright as applied to claim 1 above, and further in view of Toba et al.

Paragraph 11 of the previous office action contains the text of this rejection.

Response to Amendment

15. The declaration under 37 CFR 1.132 filed June 9, 2003 is insufficient to overcome the rejection of claims 1, 3, 4, 6-9, and 11-12 based upon Okoroafor et al. or Ormsby et al. as set forth in the last Office action because: the scope of the structures the applicant claims overlap the structures found in the references. In addition, the applicant appears to be depending on elements not found in the claims to differentiate the claims from the prior art.

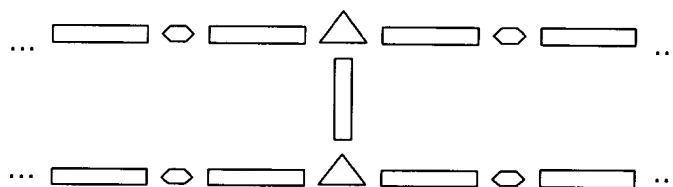
Response to Arguments

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16. Applicant's arguments filed June 9, 2003 have been fully considered but they are not persuasive.

17. The applicant argues that Ormsby et al. does not anticipate the present invention for numerous reasons and submitted a declaration to that effect. The declaration is not persuasive to overcome the application of Ormsby et al. to the present application because the rejection is based on the fact that the scope of the claim language overlaps the chemical structures disclosed by Ormsby et al. The declaration may provide some evidence for unexpected results, but does not address the issue that the structure provided for in Ormsby et al. overlaps the scope of the present claims. The examiner wishes to draw the applicant's attention to the following example:

The polymer in Ormsby et al. is made from a diisocyanate, a diol, and a triol, and may be diagrammed as such:



Where the diisocyanates are represented as the rectangles, the diols are the hexagons, and the triols are the triangles. This structure also meets the applicant's defined structures in claim 1, where the polyurethane prepolymer are represented in the above diagram by the rectangle-

hexagon-rectangle sequences, and the curing agent is represented by the triangle-rectangle-triangle sequence.

Since the declaration does not overcome this aspect of the rejection, the examiner maintains the rejection.

18. The applicant also appears to argue that the definition of term, "photochromism" as it appears in the claims is different than the definition of the term, "photochromism" as it is known in the art. If this is the argument the applicant is making the examiner notes that though the applicant may be their own lexicographer, there is no support for this definition in the specification and further, the applicant may not define a term such that its meaning is repugnant to its common usage. This aspect of the applicant's arguments is therefore not persuasive.

19. Regarding the applicant's belief that the structures in Ormsby et al. and the present application are different because the crosslinking agents in Ormsby et al. are only catalysts, while the curing agents in the present application are part of the final product, the examiner respectfully disagrees with this interpretation of the reference. The curing agent in Ormsby et al. is not merely a catalyst for the reaction and does become a part of the final product. Therefore this aspect of the applicant's arguments is not persuasive.

20. The applicant also argues that Ormsby et al. does not anticipate the present invention because the CR-39 lenses it discloses are not polycarbonate. The applicant states that the poly (allyldiglycol) carbonate that is CR-39 is not a polycarbonate. The examiner respectfully disagrees. Poly (allyldiglycol) carbonate is a type of polycarbonate. Therefore, it meets the applicant's claimed limitation of being a polycarbonate resin (see claim 1). The applicant's additional argument that poly (allyldiglycol) carbonate is not the same as poly (bisphenol-A) carbonate is not persuasive because though the two are different compounds, the applicant has not claimed poly (bisphenol-A) carbonate and has only claimed a broad polycarbonate resin. CR-39 is a polycarbonate resin, and therefore the examiner maintains this aspect of the rejection.

21. The applicant argues that Okoroafor et al. is not applicable to the present invention because it discloses a polythiourethane, not a polyurethane as the applicant claims. The examiner notes that a polythiourethane, because it contains multiple urethane linkages in its backbone, is a type of polyurethane and therefore meets the applicant's 'polyurethane' limitation. Since the reference also meets the other chemical structure limitations of the claims, this argument is not persuasive.

22. Regarding the applicant's arguments that Okoroafor et al. does not apply to the present invention because the nonfugitive end groups may form oligomers and that the end groups will deactivate photochromic compounds, the examiner notes that the

present claim language does not preclude the presence of oligomers in the photochromic layer and that the passage the applicant points to in order to support the position that photochromic compounds are incompatible with the polyurethane composition in Okoroafor et al. only states that if the photochromic layer is made in a certain manner that some photochromic compound may become deactivated. This negative effect may be overcome by adding more photochromic compound or by adding the photochromic compound at some other point in the synthesis of the photochromic polyurethane. Okoroafor et al. does not teach away from using photochromic compounds in its invention, so these aspects of the applicant's arguments are not persuasive.

23. The applicant appears to argue unexpected results regarding the application of Perrott et al., but the examiner sees no evidence to support this position.

24. The applicant's arguments with regard to Toba et al. are also not persuasive. The examiner relied on Toba et al. to show that TDI is well-known in the art as a common diisocyanate for use in a urethane reaction, as called for in Okoroafor et al. The examiner maintains this aspect of the rejection.

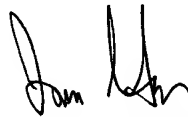
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
August 5, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700